

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEHAN CLEMENTS

Appeal No. 2000-0788
Application No. 09/017,618

ON BRIEF

Before STAAB, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 20, which are all of the claims pending in this application.

We REVERSE and REMAND.

BACKGROUND

The appellant's invention relates to a "do-it-yourself" storytelling book which allows a parent, child or teacher to create their own storytelling book which is specially adapted to allow the creator to relate a story to another person or group of persons (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Yerkes 1965	3,166,342	Jan. 19,
Holson 1973	3,720,130	Mar. 13,
Kapiloff 1992	5,102,338	April 7,
Petteway 1997	5,626,365	May 6,

Claims 1 to 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Petteway, Holson, Kapiloff and Yerkes.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted

rejection, we make reference to the answer (Paper No. 11, mailed October 25, 1999) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 10, filed September 7, 1999) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 20 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d

1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47

USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than

expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein).

The appellant argues (brief, pp. 4-6) that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require the book pages of the storytelling flip-over book to be created by inserting original insertion pages and corresponding insertion pages into page holders such that the original insertion pages and the corresponding insertion pages are arranged in diametric contraposition and the page holders are bound together into an easel-like arrangement. However, these limitations are not suggested by the applied prior art. In that regard, while

every element of the claimed invention may be found in the applied prior art, such is insufficient to defeat patentability of the claims under appeal since we fail to see any motivation, suggestion or teaching for a person having ordinary skill in the art to have combined the applied prior art to arrive at the claimed invention.

In our view, the only suggestion for modifying the applied prior art in the manner proposed by the examiner (answer, pp. 3-4) to meet the above-noted limitations stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 at 1553, 220 USPQ at 312-13. It follows that we cannot sustain the examiner's rejections of claims 1 to 20.

REMAND

We remand this application to the examiner to further consider the patentability of claims 1 to 20 under 35 U.S.C.

§ 103 in light of the prior art of record and the following prior art not of record: (1) U.S. Patent No. 5,586,786 which teaches an easel show file display book which utilizes a plurality of transparent envelopes;¹ (2) U.S. Patent No. 5,836,614 which teaches alternative orientation of books in Figures 1 and 2; and (3) U.S. Patent No. 3,028,178 which seems to teach that the book's hinge can be placed at either the top (Figure 7) or side (Figure 1). In addition, the examiner should determine whether or not it was old and well known in the art at the time the invention was made that storytelling books had two alternative orientations, one orientation being with the binding of the book being on the left side of the book and the other orientation being with the binding of the book being at the top of the book.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 20 under 35 U.S.C. § 103 is reversed. In

¹ The examiner should determine if an artisan would have understood that the transparent envelopes contained pages having indicia thereon.

addition, the application has been remanded to the examiner
for further consideration.

REVERSED; REMANDED

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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